R E M A R K S

Claims **1 - 27** were pending in the present application.
Claims **1 - 30** will be pending after entry of this amendment.
Claims **1 - 7, 16 and 25 - 27** will be amended.
Claims **28 - 30** have been added.
Claims **1 - 7, 16, and 25 - 30** are independent.

Double Patenting Rejections

The Examiner has advised Applicant that Claim **25 and 26** are substantial duplicates. Specifically, the Examiner states that that the fifth steps of claim **25**:

> *allowing an exchange of the at least one item and the first item for the rounded purchase price.*

is substantially the same as the fifth step of claim **26**:

> *receiving the rounded purchase price in exchange for the at least one item and the first item.*

It is well-established that there is presumed to be a difference in meaning and scope when, as here, different words or phrases are used in separate claims. *Tandon Corp. v. U.S. International Trade Commission*, 4 USPQ2d 1283 (Fed. Cir. 1987). Further, as the Examiner notes, two claims are substantial duplicates if they are directed to identical subject matter. Accordingly, two claims are not substantial duplicates if one could be literally infringed without literally infringing the other. MPEP 804(II)(A); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

One of claims **25 and 26** can be literally infringed without literally infringing the other. As one example, one way an entity could "allow an exchange" according to claim **25** would be by

    (i)   allowing a customer to take home the at least one item and the first item, and

    (ii)   storing an "account receivable" entry indicating that the customer owed (but had not paid) the rounded purchase price.

However, if the entity did not receive the rounded purchase price, the entity would not meet the limitations of the fifth step of claim **26**.

The example above is merely one of several which demonstrate that claims **25 and 26** are not substantial duplicates. The above example is not a description of the scope of either of claims **25 or 26**, or any limitations thereof.

Section 101 Rejections

Claims **1 - 24** stand rejected as being non-statutory. Applicant respectfully traverses the Examiner's Section 101 rejection.

The Examiner has rejected the claims as directed to mere abstract ideas because:

(i) the claims do not recite pre- or post-computer activity and do not perform physical acts outside of a computer (Office Action, page 4); and

(ii) there is no "application of the result" of the claim (Office Action, page 8);

With respect to part (i) above, Applicant notes that recitation of pre- or post-solution activity / physical transformation is not a requirement for method claims; it is merely one of many types of statutory computer-related claims, as discussed at length in the Amendment and Response to the Non-final Office Action Mailed february 13, 2001.

With respect to part (ii) above, the Examiner believes that none of claims **1 - 24** include "steps which process sales or apply the result of the mathematical algorithm in a useful way." (Office Action, page 8). However, the present claims are directed to rounding of purchase prices, and not manipulation abstract numbers or variables. Accordingly, the present invention has a practical application in processing purchase prices, a clearly concrete application. Further, a result of all rejected claims is, among other things, a rounded purchase price - a useful, concrete and tangible result which is accepted and relied upon, e.g., by an entity selling something for the rounded price. That the claims might be considered *broad* (i.e. lack various steps the Examiner believes relate to sales activities) has nothing to do with whether the claims are statutory.

Section 112 Rejections

Claims **1 - 24** stand rejected under 35 U.S.C. § 112, 2nd paragraph, as being incomplete for omitting essential steps. Applicant respectfully traverses the Examiner's Section 112 rejection.

The Examiner has characterized the rejected claims as "incomplete for omitting essential steps". MPEP § 2172.01 states that a rejection for unclaimed essential matter is to be made under 35 U.S.C. § 112, 1st paragraph, and only when a claim "omits matter disclosed to be essential to the invention as described in the specification or in other statements of record". Accordingly, an essential elements rejection is a rejection for lack of enablement of the claimed invention, not indefiniteness. MPEP § 2172.01, first paragraph.

To maintain such a rejection, the specification or other statements must describe the matter as essential to the invention (i.e. the invention could not be practiced without the matter). MPEP § 2172.01, first paragraph. Nowhere have the allegedly "essential elements" been described as necessary to practice the invention. The rejection is based solely on the claim preambles, which according to the Examiner, define a "goal" which is not "accomplished" by the claimed steps. This is not a proper basis for a rejection, much less a basis provided for by 35 U.S.C. § 112.

In addition, broad language in the disclosure that omits an allegedly critical feature tends to rebut the argument of criticality. MPEP § 2164.08(c). Applicants note that the present specification discloses embodiments that omit the allegedly essential features. For example, FIG. 8 and the accompanying text at page 12 of the present application do not include the features the Examiner claims are essential.

Finally, Applicant notes that features that are merely preferred are not to be considered critical, and thus need not be recited in claims. MPEP § 2164.08(c).

Section 103(a) Rejections

Claims **1 - 27** are rejected as being unpatentable over Fiorini. Applicant respectfully traverses the Examiner's Section 103(a) rejection.

Each of Claims 1 - 27.

Each rejected claim recites *"receiving a rounding code"*. None of the references, nor the statements in the Examiner's affidavit dated February 22, 2001, nor the subject matter of the Examiner's Offical Notice, alone or in combination, teach or suggest this limitation.

Further, each rejected claim generally recites a limitation of *"rounding a purchase price based on the rounding code" (or on a plurality of rounding codes) (or on the rounding multiple that corresponds to the received rounding code)*. None of the references, nor the statements in the Examiner's affidavit dated February 22, 2001, nor the subject matter of the Examiner's Offical Notice, alone or in combination, teach or suggest this limitation.

Fiorini discloses that:

"Kroger and Winn-Dixie supermarkets offer to round purchases up and donate the difference to charities."

and:

"Curt Sheely, general manager at Christie's Café and Bakery in Richmond, Va. already rounds up or down to avoid taking pennies."

There is no teaching or suggestion in Fiorini of how prices may be rounded at all, much less that prices are rounded based on a rounding code, much less that prices are rounded based on a received rounding code. Indeed, from the "Christie's Café and Bakery" example reproduced above, it appears the amount rounded up was to the nearest five cents, since the purpose of rounding at this store is "to avoid taking pennies". Accordingly, since no rounding code is utilized, receiving a rounding code cannot be taught or suggested either.

Further, even if all the statements in the Examiner's affidavit dated February 22, 2001 are true, there is no teaching or suggestion of how prices may be rounded at all, much less that prices are rounded based on a rounding code, much less that prices are rounded based on a received rounding code. Accordingly, since no rounding code is utilized, receiving a rounding code cannot be taught or suggested either.

In page 6 of the Office Action, the Examiner states that in the Fiorini reference "the rounding code is inferred to be to the closest nickel". However, even with this interpretation of Firoini, there is no teaching or suggestion in Fiorini of a code, much less receiving a code, much less rounding based on the received code. At best, in Fiorini it would appear that prices are always rounded to the same multiple (i.e. a nickel). Thus, there can be no rounding based on a code of a plurality of different rounding codes. There would also be no need to receive a code in such a system.

Independent Claims 1 and 2.

Each of independent claims **1 and 2** have been amended to clarify that the received rounding code is *a rounding code of a plurality of different rounding codes*. None of the references cited by the Examiner disclose this limitation. Such a limitation would serve no useful purpose in any of these references.

Independent Claims 3 -6.

Each of independent claims **3 - 6** have been amended to clarify that the rounding multiple is *a rounding multiple of a plurality of different rounding multiples*. None of the references cited by the Examiner disclose this limitation. Such a limitation would serve no useful purpose in any of these references.

Independent Claims 7 and 16.

Each of independent claims **7 and 16** generally recite the limitation of

receiving a plurality of rounding codes, each rounding code having a corresponding rounding multiple and fixed price

None of the references cited by the Examiner disclose this limitation, and the Examiner has not indicated why such a limitation would be obvious. Such a limitation would serve no useful purpose in any of these references. Specifically, none of the references would benefit from receiving a plurality of rounding codes, since none of the references contemplate doing anything with a received rounding code.

Dependent claims 8 - 15 and 17 - 24

The Office Actions mailed June 6, 2000 and February 13, 2001 do not indicate why any of dependent claims **8 - 15 and 17 - 24** are rejected as obvious. In both Office Actions, the discussion of these rejected claims refers only to the limitation of independent claims **7 and 16** that *each rounding code having a corresponding rounding multiple and fixed price*. The respective limitations of the dependent claims are not discussed. Accordingly, the Examiner has not met the prima facie burden with respect to rejected claims **8 - 15 and 17 - 24**, and a final rejection is improper.

For example, dependent claims **13 and 22** each generally recite the following limitation:

selecting a rounding code having a rounding multiple that is not greater than the rounding multiple of each unselected rounding code

which is not disclosed or suggested by the references. Similarly, dependent claims **15 and 24** each generally recite the following limitation:

the fixed price and the rounding multiple of each rounding code are equal

which is not disclosed or suggested by the references.

Independent Claims 25, 26 and 27

Each of independent claims **25, 26 and 27** as amended recite the following limitation:

receiving a rounding code from a first item not included in the purchase;

As discussed above, none of the references disclose or suggest rounding codes, much less received rounding codes. In addition, none of the references disclose or suggest that the received rounding code is from a first item not included in the purchase. Such a limitation would serve no useful purpose in any of these references.

Official Notice

The Examiner has utilized various officially noted subject matter in the obviousness rejection of the claims in both previous Office Actions. At page 6 of the Amendment and Response mailed December 6, 2000, Applicant had disputed (and still dispute) the assertions that were characterized as well known and requested (and hereby request again) references in support thereof, pursuant to MPEP 2144.03. The Examiner's responded in pages 11 - 12 of the Office Action that such a reference was not necessary unless Applicant provides adequate information or argument that on its face creates reasonable doubt as to the officially noted subject matter.

Applicants respectfully disagree that the burden shifts to Applicant in this manner. Applicant had rebutted the statement on page 6 of his Amendment and Response mailed December 6, 2000. The *In re Ahlert* decision discussed by the Examiner is inapplicable, as that decision deals with facts noted by the Patent Office Board of Appeals, not material forming the basis for a prima facie case of obviousness during examination of an application. Further, such facts must be "capable of such instant and unquestionable demonstration as to defy dispute". *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970). Further, in that same case the C.C.P.A. stated that:

> This rule is **not**, however, **as broad as it first might appear**, and this court will always construe it narrowly and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work recognized as standard in the pertinent art** and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.

Id. (emphasis added).

Finally, Applicant notes that the Examiner has misquoted the *In re Boon* decision at page 12 of the Office Action. *Boon* is similarly inapplicable, as it deals with facts noted by the Patent Office Board of Appeals, not material forming the basis for a prima facie case of obviousness during examination of an application.

Newly Added Claims 28, 29 and 30

Newly added independent claims **28, 29 and 30** distinguish over the references cited by the Examiner, alone or in combination, by virtue of the reasons provided above, as well as further limitations recited in claims **28 - 30**.

For example, claim **28** generally includes the following limitations:

> *selecting an integer from a plurality of integers based on the scanned bar code (that is on a first item not included in the at least one item), in which at least one of the plurality of integers is "1";*
> *determining a rounded price based on the price and the selected integer, in which the rounded price is a lowest multiple of the selected integer that is greater than the price;*

Claim **29** generally includes the following limitations:

determining a rounding multiple based on the first item (which is not included in the at least one item)
determining a rounding multiple based on the first item;
determining a rounded price based on the price and the rounding multiple, in which the rounded price is a lowest multiple of the selected integer that is greater than the price;

Claim **30** generally includes the following limitations:

selecting an integer from a plurality of integers based on the scanned bar code (on a first item that is not included in the at least one item), in which at least one of the plurality of integers is "1";
determining a rounded price based on the price and the selected integer, in which the rounded price is a lowest multiple of the selected integer that is greater than the price;
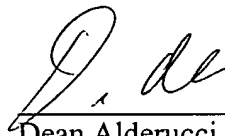
Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Applicant believes no fee is due. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

May 14, 2001
Date

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CLAIM AMENDMENTS
MARKED UP FORM

Please **AMEND** the claims as follows

1. **(AMENDED)** A method [for processing a supplementary product sale at a point-of-sale terminal,] comprising:

   receiving a rounding code <u>of a plurality of different rounding codes</u>; and

   rounding a purchase price based on the rounding code.

2. **(AMENDED)** An apparatus [for processing a supplementary product sale at a point-of-sale terminal,] comprising:

   a storage device; and

   a processor connected to the storage device,

   the storage device storing

    a program for controlling the processor; and

   the processor operative with the program to:

    receive a rounding code <u>of a plurality of different rounding codes</u>; and

    round a purchase price based on the rounding code.

3. **(AMENDED)** A method [for processing a supplementary product sale at a point-of-sale terminal,] comprising:

   receiving a rounding code, the rounding code having a corresponding rounding multiple <u>of a plurality of different rounding multiples</u>; and

   rounding a purchase price based on the rounding multiple.

4. **(AMENDED)** An apparatus [for processing a supplementary product sale at a point-of-sale terminal,] comprising:

   a storage device; and

   a processor connected to the storage device,

   the storage device storing

    a program for controlling the processor; and

   the processor operative with the program to:

    receive a rounding code, the rounding code having a corresponding rounding multiple <u>of a plurality of different rounding multiples</u>; and

    round a purchase price based on the rounding multiple.

5. **(AMENDED)** A method [for processing a supplementary product sale at a point-of-sale terminal,] comprising:

   receiving a rounding code;

   determining a rounding multiple <u>of a plurality of different rounding multiples, the rounding multiple</u> corresponding to the rounding code; and

   rounding a purchase price based on the rounding multiple.

6.   **(AMENDED)** An apparatus [for processing a supplementary product sale at a point-of-sale terminal,] comprising:
        a storage device; and
        a processor connected to the storage device,
        the storage device storing
                a program for controlling the processor; and
        the processor operative with the program to:
                receive a rounding code;
                determine a rounding multiple of a plurality of different rounding multiples, the rounding multiple corresponding to the rounding code; and
                round a purchase price based on the rounding multiple.

7.   **(AMENDED)** A method [for processing a supplementary product sale at a point-of-sale terminal,] comprising:
        receiving a plurality of rounding codes, each rounding code having a corresponding rounding multiple and fixed price;
        determining a purchase price; and
        rounding the purchase price based on the rounding codes.

16.   **(AMENDED)** An apparatus [for processing a supplementary product sale at a point-of-sale terminal,] comprising:
        a storage device; and
        a processor connected to the storage device,
        the storage device storing
                a program for controlling the processor; and
        the processor operative with the program to:
                receive a plurality of rounding codes, each rounding code having a corresponding rounding multiple and fixed price;
                determine a purchase price; and
                round the purchase price based on the rounding codes.

25.   **(AMENDED)** A [computer-implemented] method comprising:
        determining a purchase price for a purchase including at least one item;
        receiving a rounding code [for] from a first item not included in the purchase;
        determining a rounding multiple corresponding to the rounding code;
        rounding the purchase price based on the rounding multiple; and
        allowing an exchange of the at least one item and the first item for the rounded purchase price.

26.   **(AMENDED)** A [computer-implemented] method comprising:
        determining a purchase price for a purchase including at least one item;
        receiving a rounding code [for] from a first item not included in the purchase;
        determining a rounding multiple corresponding to the rounding code;
        rounding the purchase price based on the rounding multiple; and
        receiving the rounded purchase price in exchange for the at least one item and the first item.

27.   **(AMENDED)** A [computer-implemented] method comprising:

determining a purchase price for a purchase including at least one item;

receiving a rounding code [for] <u>from</u> a first item not included in the purchase;

selecting a rounding multiple from a plurality of rounding multiples based on the received rounding code;

rounding the purchase price based on the selected rounding multiple; and

receiving the rounded purchase price in exchange for the at least one item and the first item.